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## REMARKS/ARGUMENTS

The Office Action mailed January 23, 2007 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

The specification has been amended to correct minor editorial matters. No new matter has been added.

Claim 19 has been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification. No new matter has been added

The 35 U.S.C. § 101 Rejection

Claim 19 was rejected under 35 U.S.C. § 101 because the claimed invention is allegedly non-statutory. Specifically, the office action states that a "determination is not a tangible result, and thus the claim is non-statutory." Applicant respectfully disagrees. This rejection is respectfully traversed.

Claim 19 has been amended to read a "program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method for determining whether a copyright registration update is needed." It is respectfully asserted that claim 19 (as well as all claims depending therefrom) satisfy the requirements of 35 U.S.C. § 101 and it is respectfully requested that this rejection be withdrawn.

The First 35 U.S.C. § 103 Rejection

Claims 6-12, 16-17, 19-20, 22-24, and 27-31 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Freivald (USP 5,898,836) in view of Glogau (USP 5,983,351) among which claims 19 and 24 are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.) § 2143,

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Freivald except that Freivald does not teach "the websites as having any copyright registration or the steps of updating a United States copyright registration as claimed." The Office Action further contends that Glogau teaches the general principle that a website may be copyrighted and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate Freivald into Glogau in order to "incorporate copyrights registered documents in order to facilitate the protection of the intellectual property in those documents". The Applicants respectfully disagree for the reasons set forth below.

Claim 19

**A. The combination of Freivald and Glogau does not teach "determining that the copyright registration update is needed for the website based on the change indication"**

As provided in the Specification, the "registration monitoring system also includes an update registration process that serves to process updated registrations for the websites that have been determined to desire such updates." (Specification, page 8, lines 29-31). When an updated registration for a particular website is deemed appropriate or recommended, ... the requester can receive a notification from the monitoring server 302 advising that an updated registration is deemed appropriate or recommended." (Specification, page 5, lines 17-20). Thus, a determination is made whether a copyright registration update is needed for a website.

The Office Actions admits that Freivald does not teach "the steps of updating a United States copyright registration as claimed" yet argues that Freivald teaches in

"response to a sufficient degree of change in the CRC value, a determination is made for the need of an update action. The update action may [be] a correction links on the stored page (column 13, line 65- column 14, line 10)." To the extent that the Office Action argues that Freivald teaches an update action, the Office Action is improperly reading Freivald. The citation provided by the examiner merely teaches that the "webmaster can register all of the URL's of hyper links on his web page. Thus, when any of the linked pages change, the webmaster is notified." There is no update action that occurs. Rather, when the linked page changes, a notification is sent to the webmaster so that webmaster can avoid the embarrassment of failed links – no update action is taken, taught or suggested by Freivald. Thus, Freivald does not teach, disclose, or suggest "determining that the copyright registration update is needed for the website based on the change indication" as claimed in Claim 19.

**B. There is no reasonable expectation of success that the combination of Freivald and Glogau will result in the claimed invention**

The alleged combination of Freivald and Glogau will not result in the claimed invention. At best, the alleged combination would result in a system for automatically checking webpage documents, reporting a percentage of change to the user, and blanketly generate Copyright Office forms for filing with the Copyright Office without making any type of determination. For example, the alleged combination would generate Copyright Office forms for 2% percentage of change to the webpage or a 100% change without determining whether an update is really needed. Thus, the alleged combination does not determine that "a copyright registration update is needed for the website based on a change indication" as claimed in Claim 19. The alleged combination simply reports the percentage of change and no determination of a need for a copyright registration update is provided to the user.

**C. There is no motivation or suggestion to combine Freivald and Glogau**

It is well established by the courts that the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989) ("[t]he mere fact that the prior art could

be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (quoting In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). MPEP Section 2143.01 also states that the prior art must suggest the desirability of the claimed invention.

As stated above, Freivald merely teaches comparing webpages to determine a percentage of change to simply reduce "the time and effort required by a user wanting to keep abreast of changes at a web site." Glogau simply teaches a method to determine the proper copyright forms to register with the Copyright office. Nowhere does Freivald suggest, mention, or disclose updating a copyright registration nor does Glogau suggest, mention, or disclose comparing documents to determine whether an update is required. Thus, there is no suggestion or motivation in the prior art references themselves to the make the modification needed to arrive at the claimed invention. Specifically, nowhere in Freivald or Glogau does it teach or suggest "determining that the copyright registration update is needed for the website based on the change indication" as claimed in Claim 19 neither has the Examiner provided for such as finding.

The Office Action states that the Examiner "gave detailed explanation of claimed limitation and pointed out exact locations in the cited prior art." Applicants respectfully disagree. The Office Action fails to provide specific citations for the motivation or suggestion to combine the references and simply stated that "Freivald and Glogau are combinable because both of them teach registration system as claimed in the instant application."

It has been held that a general relationship between fields of the prior art references is not sufficient to suggest the motivation. *Interactive Techs. Inc. v. Pittway Corp.*, Civ. App. No. 98-1464, slip op. at 13 (Fed. Cir. June 1, 1999), cert denied, 528 U.S. 1046 (1999). The two prior arts, although related by the fact that both of them allegedly teach a registration system as asserted by the Examiner, are different and cannot be combined. "The test is not whether one device can be an appropriate substitute for another," rather, an examiner "must make specific findings establishing why it was 'apparent' to use" the combination of the prior arts. Ruiz v. A.B. Chance Co., Fed. Cir., No. 99-1557 (December 2000). "The notion . . . that combined claims can be declared invalid merely upon finding similar elements in separate prior art patents would

necessarily destroy virtually all patents and cannot be the law under the statute, §103." Id.

Accordingly, since the combination of the prior art references do not to teach all the claimed limitations, there is no reasonable expectation of success that the alleged combination would result in the claimed invention and there is no suggestion or motivation to combine the references. Thus, it can not be said that Claim 19 is obvious over Freivald in view of Glogau. It is respectfully requested that this rejection be withdrawn.

Claim 24

**A. The combination of Freivald and Glogau does not teach "storing prior registration information pertaining to the prior copyright registration of the website" or "storing the subsequent registration information pertaining to the subsequent copyright registration of the website"**

The Specification provides for the storing of information pertaining to the websites that includes "contact information and prior registration information." (Specification, page 4, lines 29-32). In contrast, Freivald merely teaches that the "URL identifying the web page and the user's e-mail address are also stored with the archived CRC's." (Col. 6, lines 57-59). Thus, only the user's e-mail address is stored and not "registration information pertaining to the prior copyright registration" or "subsequent registration information". Glogau does not teach storing of any copyright registration information much less registration information pertaining to the subsequent copyright registration. It is respectfully requested that should the Examiner maintain this rejection that a specific citation in the prior art reference be provided to show that Freivald and Glogau teach "storing prior registration information pertaining to the prior copyright registration of the website" and "storing the subsequent registration information pertaining to the subsequent copyright registration of the website" as claimed in Claim 24.

**B. The combination of Freivald and Glogau does not teach "determining that the copyright registration update is needed" or "determining update registration for a subsequent copyright registration for the website ... the update registration**

**information automatically being based at least in part on the prior registration information"**

As provided in the Specification, the "registration monitoring system also includes an update registration process that serves to process updated registrations for the websites that have been determined to desire such updates." (Specification, page 8, lines 29-31). When an updated registration for a particular website is deemed appropriate or recommended, ... the requester can receive a notification from the monitoring server 302 advising that an updated registration is deemed appropriate or recommended." (Specification, page 5, lines 17-20).

Additionally, "registration information is determined 612 based on the prior registration information. Here, the registration information that is determined 612 is for use with an update registration. By utilizing the prior registration information in determining 612 the registration information, the amount of additional information that needs to be newly provide is substantially reduced." (Specification, page 9, lines 24-29). Thus, a determination is made whether a copyright registration update is needed for a website and the registration information used is based, in part, upon prior stored registration information.

As stated above, Freivald does not teach, disclose, or suggest making a determination for a copyright update, much less "determining that the copyright registration update is needed for the website based on the change indication" as claimed in Claim 24. As also stated above, Freivald nor Glogau teaches storing any previous or subsequent registration information of any kind and thus does not teach "determining update registration for a subsequent copyright registration for the website ... the update registration information automatically being based at least in part on the prior registration information" as claimed in Claim 24.

**C. The combination of Freivald and Glogau does not teach "initiating the subsequent copyright registration for the website with the U.S. Copyright Office"**

Neither Freivald nor Glogau discuss, disclose, or teach initiating a subsequent copyright registration with the U.S. Copyright Office. It is respectfully requested that

should the Examiner maintain this rejection that a specific citation to the prior art references be provided to show that Freivald or Glogau initiate a subsequent copyright registration for the user.

**D. There is no reasonable expectation of success that the combination of Freivald and Glogau will result in the claimed invention**

The alleged combination of Freivald and Glogau will not result in the claimed invention. As noted above, the alleged combination would, at best, result in a system for automatically checking webpage documents, reporting a percentage of change to the user, and blanketly generating Copyright Office forms for filing with the Copyright Office.

The alleged combination would not provide for 1) "storing prior registration information pertaining to the prior copyright registration of the website"; 2) "storing the subsequent registration information pertaining to the subsequent copyright registration of the website"; 3) "determining that the copyright registration update is needed"; 4) "determining update registration for a subsequent copyright registration for the website ... the update registration information automatically being based at least in part on the prior registration information"; or 5) "initiating the subsequent copyright registration for the website with the U.S. Copyright Office" as claimed in Claim 24.

**E. There is no motivation or suggestion to combine Freivald and Glogau**

Freivald does not suggest, mention, or disclose updating a copyright registration nor does Glogau suggest, mention, or disclose comparing documents to determine whether an update is required. Thus, there is no suggestion or motivation in the prior art references themselves to the make the modification needed and neither has the Examiner provided for such as finding.

The Office Action states that the Examiner "gave detailed explanation of claimed limitation and pointed out exact locations in the cited prior art." Applicants respectfully disagree. The Office Action fails to provide specific citations for the motivation or suggestion to combine the references and simply stated that "Freivald and Glogau are combinable because both of them teach registration system as claimed in the instant application."

It has been held that a general relationship between fields of the prior art references is not sufficient to suggest the motivation. *Interactive Techs. Inc. v. Pittway Corp.*, Civ. App. No. 98-1464, slip op. at 13 (Fed. Cir. June 1, 1999), cert denied, 528 U.S. 1046 (1999). The two prior arts, although related by the fact that both of them allegedly teach a registration system as asserted by the Examiner, are different and cannot be combined. "The test is not whether one device can be an appropriate substitute for another," rather, an examiner "must make specific findings establishing why it was 'apparent' to use" the combination of the prior arts. Ruiz v. A.B. Chance Co., Fed. Cir., No. 99-1557 (December 2000). "The notion . . . that combined claims can be declared invalid merely upon finding similar elements in separate prior art patents would necessarily destroy virtually all patents and cannot be the law under the statute, §103." Id.

Accordingly, since the combination of the prior art references do not to teach all the claimed limitations, there is no reasonable expectation of success that the alleged combination would result in the claimed invention, and there is no suggestion or motivation to combine the references, it can not be said that Claim 24 is obvious over Freivald and Glogau. It is respectfully requested that this rejection be withdrawn.

As to the dependent claims, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable. In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

The Second 35 U.S.C. § 103 Rejection

Claim 12, 15, 16, 32, and 33 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Freivald in view of Glogau and further in view of Information Today. This rejection is respectfully traversed. Claims 12, 15, 16, 32, and 33 depend from independent Claims 19 or 24. Accordingly, the arguments set forth above are equally applicable to these claims. The base claims being allowable, the dependent claims must also be allowable. In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

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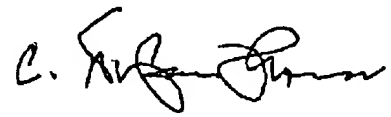
Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited and Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,



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